

REMARKS

Applicants thank the Examiner for the thorough examination given the present application.

Status of the Claims

Claims 1 and 3-4 are pending in the present application. Claim 1 has been amended to delete the limitation of “9000 or more” and to further define “P.” Support for the recitations in claim 1 can be found in the examples of the present specification. Thus, no new matter has been added.

Applicants submit that the present Amendment is merely formal in nature, is in accordance with the Examiner’s instructions, reduces the number of issues under consideration, and places the case in condition for allowance. Alternatively, entry of the present amendment is proper to place the claims in better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserts that the limitation of “9000 or more” for the number average molecular weight is new matter since page 27, line 20 of the present specification only recites a value of 9,560. Applicants respectfully traverse in view of the amended claim.

Claim 1 has been amended by deleting this limitation from the claim. As such, Applicants respectfully submit that the outstanding rejection has been overcome and should be removed.

Issues over the Cited References

1) Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Nakagawa et al. '688 (U.S. 6,274,688). Applicants respectfully traverse. Reconsideration and withdrawal of the outstanding rejection are respectfully requested based on the following considerations.

Nakagawa et al. '688 disclose, "From the viewpoint of physical properties of products, styrenic monomers and (meth)acrylic monomers are preferred. More preferred are acrylic acid ester monomers and methacrylic acid ester monomers.... In the practice of the present invention, these preferred monomers may be copolymerized with another or other monomers and, on that occasion, said preferred monomers preferably account for at least 40% by weight" (col. 5, lines 41-49).

However, the polymer disclosed in Nakagawa et al. '688 is not the same polymer as the polymer of the present invention. Enclosed herewith is a 37 CFR § 1.132 Declaration of Nobuo Kawahara. The Examiner is respectfully requested to review the enclosed Declaration of Nobuo Kawahara as it provides strong evidence of the patentability of the present invention.

In the enclosed Declaration, additional test data are set forth. Specifically, experiments were done according to the description of Nakagawa et al. '688. The results in the Declaration show that it is impossible to homo-polymerize non-polar olefin monomers by an ATRP method, which is disclosed in Nakagawa et al. '688. Further results can be found in the enclosed Declaration. From the experiments described in the Declaration, the polymer disclosed in Nakagawa et al. '688 is not the same as the polymer of the present invention.

Accordingly, the present invention is not anticipated by Nakagawa et al. '688 since the reference does not teach or provide for each of the limitations recited in the pending claims.

2) Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakagawa et al. '688 in view of Kioka et al. '495 (US 5,939,495). Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

As discussed above, Nakagawa et al. '688 do not disclose each and every aspect of claim 1, from which claim 3 depends. Specifically, Nakagawa et al. '688 do not disclose a telechelic polyolefin of the present invention, such as polyethylene, polypropylene and poly-1-octene, and

a copolymer of n-butylacrylate with ethylene, propylene, or 1-octene having a molecular distribution as specified in claim 1 of the present invention.

Applicants respectfully submit that Kioka et al. '495 do not overcome these deficiencies. Kioka et al. '495 disclose a single-chain-end functionalized polyolefin but do not disclose a telechelic polyolefin of the present invention.

To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be disclosed by the cited references. As discussed above, Nakagawa et al. '688 in view of Kioka et al. '495 fail to disclose all of the claim limitations of independent claim 1, from which claim 3 depends. Accordingly, the combination of references does not render the present invention obvious. Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejection is respectfully requested. Any contentions of the USPTO to the contrary must be reconsidered at present.

3) The rejection of claim 1 under 35 U.S.C. § 102(e) as being anticipated by Sawaguchi '834 (US 7,125,834) was withdrawn in view of the amendment requiring a Mn of 9,000 or more. This recitation has been removed from the claims, so Applicants will now respond.

4) Claims 1 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sawaguchi '834 in view of Kioka et al. '495.

Applicants respectfully traverse. Reconsideration and withdrawal of these rejections are respectfully requested based on the following considerations.

Applicants respectfully submit that Sawaguchi '834 is not prior art. The Examiner appears to assert Sawaguchi '834 as a reference under 35 U.S.C. § 103/102(e). However, in order for Sawaguchi '834 to have a 35 U.S.C. § 103/102(e) date, the international application must have been published by WIPO in the English language. Sawaguchi '834 was not published in the English language.

To the extent that the corresponding publication of Sawaguchi '834 (US 2004/0022757) may be considered prior art, Applicants claim the benefit of foreign priority for JP 2003-302240. Applicants have filed herewith a certified English translation of the foreign priority document having a filing date of August 27, 2003. The foreign priority document supports the invention as presently claimed.

Applicants have perfected a claim to priority under 35 U.S.C. § 119, and the foreign priority date antedates the publication date of the corresponding publication of Sawaguchi '834. As such, the reference cannot be considered prior art, and withdrawal of the rejections is respectfully requested.

5) Claim 4 is rejected under 35 U.S.C. § 102(b) as being anticipated by Nubel et al. '383 (US 5,731,383). Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

Nubel et al. '383 disclose a telechelic polyolefin, which is produced by a process comprising step 1) of contacting a single-chain-end functionalized polymer and a catalyst and step 2) of polymerizing with cycloolefin (col. 9, lines 15-35). By the method of Nubel et al. '383, the obtained polymer necessarily has a double bond in the main polymer chain because of a ring-opening polymerization.

In stark contrast, the polymer claimed in claim 4 does not have a double bond in its main polymer chain when the cycloolefin is polymerized by the process specified in claim 4.

Accordingly, the present invention is not anticipated by Nubel et al. '383 since the reference does not teach or provide for each of the limitations recited in the pending claims.

For completeness, Applicants also respectfully submit that Nubel et al. '383 do not render the present invention obvious because neither the reference nor the knowledge in the art provides any disclosure, reason, or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed.

CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 1 and 3-4 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink (Reg. No. 58,258) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted, #28977

By 

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Attachments: Certified English Translation of JP 2003-302240
37 CFR § 1.132 Declaration of Nobuo Kawahara